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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,787	05/14/2001	Akihisa Murata	Q64434	7102

7590 12/28/2004

SUGHRUE, MION, ZINN,
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2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 10/25/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-12 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 7-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in the last two lines of claim 7 (and also the last two lines of claim 12) the phrase "wherein at least one . . . is applied to the substrate" is not understood since it is believed the substrate is coated on at least one outer surface (and quite possibly both) with an adhesive layer and therefore the relationship of the inorganic materials, organic materials and (in claim 7) organic antistatic agents with respect to their physical relationship of being located on the substrate is not understood. Additionally, the same rationale is used in claim 8 for the phrase "antistatic agent layer is formed on at least one side of the substrate".

3. Claims 2-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Japanese Patent Abstract -164 or its complete translation, or, alternatively, applicants' admissions regarding the prior art on page 1 of the specification, each taken in view of the complete English translation of JP -910; the primary references also being further modified by evidence of the state of the art as set forth in PG

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Pub -515 to Shibata et al., substantially for reasons of record, together with the following additional observations. Initially, the Examiner notes that, upon reconsideration, two references which were relied upon in the last Office action as evidence of the state of the art, namely machine translations of JP -223 or JP -943 are no longer relied upon since they are believed to be cumulative. To partially reiterate, JP -164 discloses a thermally releasable pressure sensitive adhesive sheet comprising a thermally expandable microsphere-containing pressure sensitive adhesive layer coated onto a suitable base and which optionally employs a rubber-like organic elastic layer such as applicants claim in their dependent claims 4 and 10. Additionally, applicants admit on page 1 of their specification that heat peelable pressure sensitive adhesive sheets can comprise a suitable adhesive coated onto a substrate, the adhesive comprising heat-expandable microspheres and which result in an adhesive sheet that can be easily peeled from the adherend. The prior art "primary references" each lack a teaching of the claimed surface resistivity performance parameter, i.e., a minimal layer of antistatic behavior, and also fail to teach surface roughnesses of the type which applicants claim. The secondary reference, JP -910, however discloses (note, e.g., paragraphs 0004-0007, particularly paragraph 0005, as well as

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paragraph 0032 and the Examples) pressure sensitive adhesive compositions and coated articles which exhibit surface resistivity values of the claimed range when either coated onto a suitable backing, i.e. polyester films such as are now set forth in applicants' independent claim 3 or also embodiments in which the antistatic compositions can be "applied to the substrate" as set forth in independent claim 7 of the range which applicants contemplate. Note that in paragraph No. 0005 of JP '910 it is disclosed that antistatic agents can be treated in several methods when applied or coated on a base film, the particular choice of which is firmly believed to be an obvious modification to one of ordinary skill. With respect to the roughness parameter, note again Shibata et al., particularly at page 2, paragraph 0012 wherein it is taught that pressure sensitive adhesive layers often exhibit surface roughnesses of 1 micron or less when formed by suitable known surface modification treatments, and by doing so improve the resulting bonding properties of the protective or release sheets to the adhesive layer. Finally, with respect to newly presented dependent claim 12, which now has deleted from the Markush claim member of claim 7 (organic antistatic agents), the Examiner respectfully notes that organic antistatic agents are believed to be organic conductive materials, i.e. one of the two subgenuses set forth in

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newly presented dependent claim 12. Finally, with respect to applicants' remarks, it is noted that virtually all of their comments are directed to the presence of the two references cited as evidence of the state of the art, JP -223 and JP -943, which are no longer present in the rejection.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Serial No. 09/853,787

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Dzirker:cdc

December 21, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zirker